

REMARKS

Applicants have filed a Request for Continued Examination concurrent with this Amendment and respectfully request reconsideration of this application, and reconsideration of the Advisory Action and Final Office Action dated September 9, 2003 (Paper No. 23). Upon entry of this Amendment, claims 33, 34, 36, 38, and 40-97 will remain pending in this application with claims 42-54, 60, 61, 63, 68, 69, 71, 72, 75-87 and 90-97 being withdrawn. The amendments to the claims are supported by the specification and original claims. Particularly, the amendment to claim 33 (i.e. the aspartyl moiety) finds support at page 23, Example 7. No new matter is incorporated by this Amendment.

Applicants wish to thank the Examiner for meeting with Applicants on April 22, 2004 to discuss the present application. As stated in the Examiner's Interview Summary, the rejections and the cited art were discussed. Applicants also wish to point out that they submitted that none of the cited art of record teach or fairly suggest employing an aspartyl moiety to stabilize a biotinamide bond to inhibit enzymatic cleavage. Moreover, Applicants have amended the claims to refer to stabilization via an aspartyl moiety.

* * * * *

Claims 33-41, 55-59, 62, 64-67 and 70 are rejected under 35 U.S.C. §101 as purportedly claiming the same invention as that of claims 1-10, 17-19, 21 and 23 of co-pending application no. 09/519,998. Applicants respectfully traverse this rejection and reassert the comments made in the Amendment filed March 8, 2004.

The M.P.E.P. teaches, to make a double patenting rejection under 35 U.S.C. §101, the inventions of the two applications must be drawn to identical subject matter. See M.P.E.P. § 804(II). The M.P.E.P. further teaches:

A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. MPEP 804(II)(A).

The claims of the copending application and those of the present application are of different scope. Accordingly, identical subject matter is not claimed by both applications. Hence, the rejection is improper and should be withdrawn. Applicants respectfully request that this rejection be reconsidered and withdrawn.

* * *

Claims 33-41, 54-59, 62, 64-67, and 70-74 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Applicants also again reassert the comments made in the March 8, 2004 Amendment since the amendments made to the claims via that Amendment are now entered and under consideration.

In the Office Action, it is asserted that the terminology “derivation of” in claim 33 is indefinite. In response, claim 33 has been amended to recite “comprising biotin or a biotin derivative having essentially the same binding function to avidin or streptavidin as biotin.” Hence, claim 33 as amended fully complies with 35 U.S.C. §112.

Claim 70 has been amended to recite “wherein compounds 41, 42, and 44 are stabilized against enzymatic cleavage by biotinidase.” Thus, claim 70 includes a “.” and fully complies with 35 U.S.C. §112.

The amendments to the claims and above remarks overcome this rejection. Hence, reconsideration and withdrawal of the rejection are respectfully requested.

* * *

Claims 33-35, 39-41, 55-59, 62, 64-67, 73, 74, 88, and 89 are rejected under 35 U.S.C. § 102(b) as purportedly anticipated by Wilbur et al. (WO 97/29114). The Office Action asserts that Wilbur discloses every element of the claimed invention. Applicants respectfully traverse.

As an initial matter, Applicants again submit that this rejection is improper since Wilbur does not qualify as prior art under 35 U.S.C. §102(b). To qualify as prior art under 35 U.S.C. §102(b) a document must show, “(b) the invention was patented or described in

a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.” 35 U.S.C. § 102(b). Wilbur was published August 14, 1997. The present application claims the benefit of PCT/SE98/01345 which was filed on July 7, 1998. Moreover, Applicants submit herewith a certified copy of priority document PCT/SE98/01241, thereby perfecting Applicants claim for priority. Hence, the Wilbur document was neither patented nor described in a printed publication in this or a foreign country more than one year prior to the earliest date to which the present application is entitled. Hence, the rejection is improper and should be withdrawn.

Applicants also reassert and incorporate the arguments presented in the last Amendment. As mentioned in the last Amendment, Applicants have surprisingly found that introducing an aspartyl residue in linker 1, unforeseeably does not effect the binding affinity to avidin and provides, at the same time, full resistance towards enzymatic cleavage by biotinidase. Wilbur fails to teach or fairly suggest employing an aspartyl moiety to stabilize a biotinamide bond to inhibit enzymatic cleavage. Hence, Wilbur fails to teach each and every feature of independent claim 1.

The above remarks overcome this rejection. Thus, reconsideration and withdrawal of the rejection are respectfully requested.

* * *

Claims 33-41, 55-59, 62, 64-67, 70, 73, 74, 88, and 89 are rejected under 35 U.S.C. § 103(a) as being obvious based on Wilbur et al. in view of Griffiths (U.S. Pat. No. 5,482,698). Applicants again respectfully traverse.

The deficiencies of Wilbur are discussed above. Griffith fails to remedy these deficiencies. Neither Wilbur nor Griffith teach or fairly suggest employing an aspartyl moiety to stabilize a biotinamide bond to inhibit enzymatic cleavage.

In addition, Applicants reassert the comments made in the last Amendment with respect to there being no motivation provided in the cited art to combine the teachings of Wilbur and Griffith as suggested in the Office Action.

The above remarks overcome this rejection. Thus, reconsideration and withdrawal of the rejection are respectfully requested.

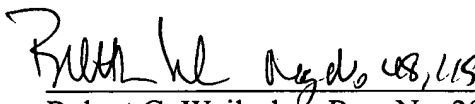
* * * * *

Applicants respectfully submit that this Amendment and the above remarks obviate the outstanding rejections in this case, thereby placing the application in condition for immediate allowance. Allowance of this application is earnestly solicited.

If any fees under 37 C.F.R. §§ 1.16 or 1.17 are due in connection with this filing, please charge the fees to Deposit Account No. 02-4300; Order No. 033700.005.

If an extension of time under 37 C.F.R. § 1.136 is necessary that is not accounted for in the papers filed herewith, such an extension is requested. The extension fee should be charged to Deposit Account No. 02-4300; Order No. 033700.005.

Respectfully submitted,
SMITH, GAMBRELL & RUSSELL, LLP

By: 
fn Robert G. Weilacher, Reg. No. 20,531
1850 M Street, N.W., Suite 800
Washington, D.C. 20036
Telephone: (202) 263-4300
Facsimile: (202) 263-4329

Dated: July 1, 2004